

Please add the following new claim.

ET ¹⁷
Claim 21 (New)

A₆

In a wireless communication system, a method for enabling a single mobile station to communicate via multiple wireless networks, the method comprising the steps of:

- registering the mobile station with a first wireless network over a control channel associated with said first wireless network;
- storing in a memory, an address of the mobile station on the first wireless network;
- registering the mobile station with a second wireless network over a second control channel associated with said second wireless network;
- storing in the memory an address of the mobile station on the second wireless network;
- associating the mobile station's stored addresses with one another in the memory;
- receiving a request that a connection with the mobile station be established over the first wireless network;
- detecting whether the mobile station is camped on to said first wireless network;
- if the mobile station is camped on to said first wireless network then establishing a connection with the mobile station over the first wireless network; and
- if the mobile station is not camped on to said first wireless network then,
 - forwarding an alert to the mobile station via the second wireless network,
 - receiving an indicator that the mobile station has camped on to said first wireless network, and
 - establishing a connection with the mobile station over the first wireless network after that mobile station camps on to said first wireless network.

REMARKS

Summary

Claim 1 to 21 are now in this application.

Claims 1 to 20 stand rejected under 35 U.S.C. § 102 in view of two references, U.S. Patent No. 5,742,905 to Pepe et al. (the Pepe patent) and U.S. Patent No. 5,533,019 to Jayapalan (the Jayapalan patent). Additionally, certain ones of the claims have been rejected under 35 U.S.C. § 112 as allegedly failing to comply with either the first or

second paragraph of that statutory section. All of these rejections will be addressed in the subsections that follow and the Applicants respectfully submit that those remarks obviate the grounds of rejection.

The Claims Comply with 35 U.S.C. § 112

Claims 3 and 9 stand rejected under 35 U.S.C. § 112, first paragraph. More specifically, the Action asserts that the phrase "paging network" does not appear in the specification. Applicants respectfully direct attention to lines 6 to 11 of page 7 at which the application refers to an alternative embodiment relating to paging networks. Reconsideration of the rejection of claims 3 and 9 is requested in view of the clear reference to such a network in the specification.

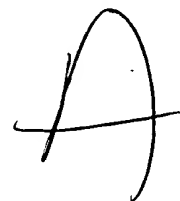
Claims 18 to 20 stand rejected under 35 U.S.C. § 112, second paragraph. More specifically, the Action asserts that the language of the last four lines of claim 18 is unclear. That claim has been amended above to include further punctuation that clarifies the relationship between the claim elements and their operation. It is respectfully submitted that this amendment removes the grounds for objecting to claim 18.

In view of the above amendments and remarks, the applicants request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112.

The Claims are Patentable Over the Prior Art

Claims 1 to 16 stand rejected under 35 U.S.C. § 102(b) in view of the Pepe patent. Claims 17 to 20 stand rejected under 35 U.S.C. § 102(b) in view of the Jayapalan patent. The Applicants submit that all of the claims are patentable over these references.

Claim 1 has been amended to more specifically indicate that the mobile station can camp on to two different over the air networks. Furthermore, the claim, as it did when originally filed, includes a step for using a stored address to send an alert. This combination is not disclosed in the Pepe patent. That reference discloses an arrangement by which a subscriber can remotely control how he or she will receive messages originally intended for receipt by any of a variety of communication devices (such as a pager, a fax machine, a wireless phone, etc.). That arrangement does not show that a mobile station, such as a wireless phone, can camp on to either of two over the air networks whereby it can receive an alert about one of the over the air networks while it is camped on to the



other over the air network. Thus, the Pepe patent does not disclose or suggest the method of claim 1.

As for claims 12 and 13, those methods have been modified to refer more specifically to wireless networks for voice and data. The Pepe patent does not disclose a mobile station that can communicate with each of these two wireless networks and can be alerted on one wireless network about a communication that awaits it on the other wireless network. Thus, the Pepe patent does not render these two claims unpatentable.

As for claim 14, this independent claim has been amended to recite the further step of "receiving an indication that said mobile station has changed network status to camp on to the network associated with the communication request." This step is directed to what happens after the mobile station has been alerted via one network that it has a communication awaiting it on another wireless network. The Pepe patent does not disclose this type of operation. The PCI network in the patent does not receive notice that the mobile station (e.g., wireless phone 32) has changed network connections. Thus, Pepe does not disclose or suggest the subject matter of claim 14.

As for dependent claims 2 to 11, 15 and 16, since their respective independent claims are patentable for the reasons enumerated above, these dependent claims are patentable as well.

Comparing claims 17 to 20 to Jayapalan, independent claim 17 discloses a memory that stores address information for a mobile station that has registered with the wireless voice and wireless data networks. Even if the Examiner is correct that some memory is inherent in the Jayapalan system, it is submitted that the reference does not disclose the memory that is the subject matter of claim 17. Thus, the reference can not be said to render that claim, or any of its dependent claims, invalid.

In view of the arguments and amendments submitted above reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 is respectfully requested.

Conclusion

All of the pending claims are supported by the specification and clearly define the Applicants' invention. Furthermore, all of the claims distinguish the invention from the prior art. Thus, issuance of a Notice of Allowance is respectfully requested.

The Office has been authorized to charge the one-month extension of time fee in a


requested filed concurrently herewith.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at (202) 429-1776 to discuss the application.

Respectfully submitted,

Date: 10/8/98


Frank Pietrantonio
(Reg. No. 32,289)

KENYON & KENYON
1025 Connecticut Avenue, N.W., Suite 600
Washington, DC 20036
Phone: (202) 429-1776
Facsimile: (202) 429-0796
172779